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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/422,360 04/17/95 LOWENSTEIN

IV HML-201-A-1
EXAMINER

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MMC2/0430

ART UNIT PLYNH, K. PAPER NUMBER

DATE MAILED 2836

04/30/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No. 08/422,360	Applicant(s) Lowenstein
Examiner Kim Huynh	Group Art Unit 2836

Responsive to communication(s) filed on Mar 30, 2001

This action is FINAL.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

Claim(s) 22, 26, 29, and 33-39 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

Claim(s) 33-35, 37, and 38 is/are allowed.

Claim(s) 22, 26, 29, 36, and 39 is/are rejected.

Claim(s) _____ is/are objected to.

Claims _____ are subject to restriction or election requirement.

Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on _____ is/are objected to by the Examiner.

The proposed drawing correction, filed on _____ is approved disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All Some* None of the CERTIFIED copies of the priority documents have been

received.

received in Application No. (Series Code/Serial Number) _____.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

DETAILED ACTION

1. The indicated allowability of claim 36 is withdrawn upon further review. The rejections are as follow.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 22, 26, 29, and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over applicant's admitted prior art (page 1, lines 1 *et seq.*) in view of Stacey and Thanawala.

Claims 22, 26, 29, and 39, despite a slight difference in wording, essentially repeat the limitations as cited in appealed claims 1-11 and 20-21 which have been affirmed by the board (Appeal No. 1997-1187, decision render 7/25/00, see pages 3-8 of the opinion) and therefore rejected accordingly.

Note the specifics of the three passive electrical components which are tuned to the third harmonic frequency are recited in the appealed claims 2 and 4.

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4. Claim 36 is rejected under 35 U.S.C. 103(a) as being unpatentable over applicant's admitted prior art (page 1, lines 1 *et seq.*) in view of Stacey and Thanawala and further in view of Gilardi et al. (US 5,243,648). Claim 36, despite a slight difference in wording, is essentially repeats the limitations as cited in appealed claims 11, 13, and 15 which have been affirmed by the board (Appeal No. 1997-1187, decision render 7/25/00, see pages 11-12 of the opinion) and therefore rejected accordingly.

Allowable Subject Matter

5. Claims 33-35 and 37-38 are allowed because they contain the same subject matter as cited in the original claims 12 and 17 which applicant was affirmed by the Board of Appeals and Interferences (decision rendered 7/25/00).

Response to Arguments

6. Applicant's arguments filed 3/30/01 have been fully considered but they are not persuasive.

a. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir.

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1992). In this case, the examiner provided the motivations for combining the references as cited in the previous office action which have been affirmed by the Board of Appeals and Interferences (decision rendered 7/25/00, see Opinion pages 3-14).

The applicant is reminded that once a PRIMA FACIE case of obviousness is established, the burden shifts to the applicant to come forward with arguments and/or evidence to rebut the prima facie case. See, e.g., Dillon, 919 F.2d at 692, 16 USPQ2d at 1901. MPEP 2144.08. The applicant failed to argue the motivation for the PRIMA FACIE case of obviousness set forth by the examiner. It is construed that the applicant acquiesces to the examiner's position.

Further more, applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

b. Regarding the declaration under 37 C.F.R. 1.132 to establish evidence of non-obviousness based upon second considerations. The examiner is not persuasive by the evidence established by declaration for the following reasons: (1) the declaration is self-serving since it is by the inventor himself, (2) the declaration fails to establish the nexus between the commercial success and the merits of the claimed invention, and (3) the declaration fails to prove that the commercial success is due to the merits of the claimed invention and not the marketing of the product itself.

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Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kim Huynh whose telephone number is (703) 308-1678.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0956.



Kim Huynh

KH

April 21, 2001